REMARKS

This response is intended as a full and complete response to the final Office Action mailed July 3, 2006. In the Office Action, the Examiner notes that claims 1, 2, 4-13 and 15-57 are pending and rejected. By this response, the claims continue unamended.

In view of the following discussion, Applicants submit that all of the claims comply with the written description requirement of 35 U.S.C. §112, paragraph 1, and none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103.

It is to be understood that Applicants do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response.

35 U.S.C. §112 Rejection

The Examiner has rejected claims 1, 11, 23, 31 and 41 under 35 U.S.C. §112, paragraph 1, as failing to comply with the written description requirement. Applicants respectfully traverse the rejection. Specifically, the Examiner alleges: "In particular, the specification does not disclose a hardware upgrade which comprises an interface to the set top terminal for receiving and processing subscriber input..." That limitation has been removed by a previous amendment in a previous response. Furthermore, the Office Action states that, "The Examiner has reviewed the portions pointed out by the applicant as well as pages 54-59 of the specification, and finds support for an interface, which passes data, but lack support for communicating video signals."

Also stated in the prior response, the priority document discloses on page 54, first full paragraph that the interface communicates video signals. Specifically, that paragraph includes at least "hardware upgrade port 662 should accommodate at least a four-wire connection for... (3) decompressed video output... and (4) video input port. Thus, the specification explicitly discloses an interface for communicating video signals between the set top terminal and the hardware upgrade. Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

Moreover, the Examiner stated in the Response to argument that, "While there is evidence for video input and output via port 622, there is no disclosure for a disc storage device, which provides video signals." As stated in the claims, the disc storage device provides local storage capacity. The priority document does disclose that feature in the sections stated above. Therefore, whether there is disclosure in the priority document regarding disc storage device providing video signals is irrelevant. Thus, this ground of rejection should be withdrawn.

35 U.S.C. §103 Rejection of Claims 1, 2, 3, 4, 6-13, 16-36, 38-44 and 47-55

The Examiner has rejected claims 1, 2, 3, 4, 6-13, 16-36, 38-44 and 47-55 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,583,560 to Florin (hereinafter "Florin") in view of U.S. Patent 5,483,277 to Granger (hereinafter "Granger") and U.S. Patent 5,192,999 to Graczyk (hereinafter "Graczyk"). Applicants respectfully traverse the rejection.

The present application is a divisional of U.S. Patent No. 5,990,927, filed December 2, 1993, which is a continuation-in-part of U.S. Patent Application No. 07/991,074, filed December 9, 1992. The limitations of claim 1 are fully supported by the disclosure of the 07/991,074 parent application, and thus have a priority date of December 9, 1992 as stated above.

Independent claim 1 recites, in relevant part (emphasis added below):

> "an interface to the set top terminal for communicating data and video signals between the set top terminal and the hardware upgrade."

Support in the 07/991,074 parent application for this portion of claim 1 is in the first paragraph on page 54 and the paragraph spanning pages 57-58. For support for the other claim language in claim 1, please refer to the comments on pages 13-14 of the Response accompanying the RCE filed on 4/11/05. Thus, all of the limitations of claim 1 can be found disclosed in the 07/991,074 parent application.

Therefore, neither the Florin reference, filed June 22, 1993, nor the Granger reference, filed December 15, 1992, are prior art against claim 1, because these references have priority dates after the priority date of claim 1. Thus, the rejection becomes a 35 USC 103(a) rejection over the Graczyk reference.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. The Graczyk reference fails to teach or suggest all of the limitations recited in claim 1, and thus fails to teach or suggest Applicants' invention as a whole.

The Graczyk reference discloses a television circuit and an audio multimedia circuit which can be used with a personal computer (see abstract). However, the Graczyk reference does not teach or suggest many limitations of claim 1. For example, inter alia, the Graczyk reference does not teach or suggest a hardware upgrade for a set top terminal.

Thus, the Graczyk reference fails to teach or suggest Applicants' invention as a whole.

As such, Applicants submit that independent claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Moreover, independent claims 11, 23, 31 and 42 have relevant limitations that are similar to those discussed above in regards to claim 1. Therefore, independent claims 11, 23, 31 and 42 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 2, 3, 4, 6-10, 12-13, 16-22, 24-30, 32-36, 38-41, 43-44 and 47-55 depend, either directly or indirectly, from independent claims 1, 11, 23, 31 and 42 and recite additional limitations thereof. As such, Applicants submit that these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder.

Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

35 U.S.C. §103 Rejection of Claims 5, 37, 45, 46 and 56-57

The Examiner has rejected claims 5, 37, 45, 46 and 56-57 under 35 U.S.C. §103(a) as being unpatentable over Florin in view of Granger and Graczyk in further view of U.S. Patent 5,638,426 to Lewis (hereinafter "Lewis") and U.S. Patent 5,247,575 to Sprague (hereinafter "Sprague"). Applicants respectfully traverse the rejection.

As discussed above, Florin and Granger are not prior art with respect to the independent claims 1, 31 and 41. Furthermore, for at least the reasons discussed above, Graczyk does not teach or suggest Applicants' invention as a whole, as recited

in independent claims 1, 31 and 41. Accordingly, any attempted combination of the Graczyk reference with any other additional references, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to the independent claims. As such, Applicants submit that dependent claims 5, 37, 45, 46 and 56-57 are also not obvious and are patentable under 35 U.S.C. §103.

Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

35 U.S.C. §103 Rejection of Claim 15

The Examiner has rejected claim 15 under 35 U.S.C. §103(a) as being unpatentable over Florin in view of Granger and Graczyk in further view of U.S. Patent 5,432,542 to Thilbadeau (hereinafter "Thilbadeau"). Applicants respectfully traverse the rejection.

As discussed above, Florin and Granger are not prior art with respect to the independent claim 11. Furthermore, for at least the reasons discussed above, Graczyk does not teach or suggest Applicants' invention as a whole, as recited in independent claim 11. Accordingly, any attempted combination of the Graczyk reference with any other additional references, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to the independent claim. As such, Applicants submit that dependent claim 15 is also not obvious and is patentable under 35 U.S.C. §103.

Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

35 U.S.C. §103 Rejection of Claims 17-18

The Examiner has rejected claims 17-18 under 35 U.S.C. §103(a) as being unpatentable over Florin in view of Granger and Graczyk in further view of U.S. Patent 4,920,339 to Friend (hereinafter "Friend"). Applicants respectfully traverse the rejection.

As discussed above, Florin and Granger are not prior art with respect to the independent claim 11. Furthermore, for at least the reasons discussed above, Graczyk does not teach or suggest Applicants' invention as a whole, as recited in independent claim 11. Accordingly, any attempted combination of the Graczyk reference with any

other additional references, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to the independent claim. As such, Applicants submit that dependent claims 17-18 are also not obvious and are patentable under 35 U.S.C. §103.

Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

CONCLUSION

Thus, Applicants submit that none of the claims presently in the application are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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